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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of:

)Attorney Docket No.: F-281

Uday W. Joshi et al.

)Group Art Unit: 3661

Serial No.: 09/898,232

)Examiner: C. Nguyen

Filed: July 2, 2001

)Date: February 7, 2006

Confirmation No.: 1871

Title: Method and System for Customized Mail Piece Production Utilizing a Data Center

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPELLANTS' BRIEF ON APPEAL**

Sir:

This is an appeal pursuant to 35 U.S.C. § 134 and 37 C.F.R. §§ 1.191 et seq. from the final rejection of claims 1-7, 9, 18 and 19 of the above-identified application mailed Sept. 8, 2005. The fee for submitting this Brief is \$500.00 (37 C.F.R. § 1.17(c)). Please charge Deposit Account No. **16-1885** in the amount of \$500.00 to cover these fees. The Commissioner is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. **16-1885**. The Notice of Panel Decision from Pre-Appeal Brief Review was mailed on Jan. 17, 2006. Enclosed with this original are two copies of this brief.

<b><u>CERTIFICATE OF MAILING</u></b>	
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Mail Stop Appeal Briefs - Patents Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	
on <u>February 7, 2006</u> Date of Deposit	<u>Amy Harvey</u> Name of Rep.
<u>Amy Harvey</u> Signature	<u>February 7, 2006</u> Date

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I. Real Party in Interest

The real party in interest in this appeal is Pitney Bowes Inc., a Delaware corporation, the assignee of this application.

II. Related Appeals and Interferences

There are no appeals or interferences known to Appellants, their legal representative, or the assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 8 and 10-17 have been cancelled. Claims 1-7, 9, 18 and 19 are pending in this application. Claims 1, 2, 5, 9, 18 and 19 stand rejected under U.S.C. § 103(a) as being unpatentable over Mori et al. (US 5,982,994). Claims 3, 4, 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mori et al. in view of Fabel (US 6,209,779).

IV. Status of Amendments

There are no amendments to the claims filed subsequently to the final rejection of Sept. 8, 2005. Therefore, the claims as set forth in Appendix A to this brief are those as set forth before the final rejection.

V. Summary of Claimed Subject Matter

This summary and references to specific page and line numbers, figures and reference characters is not intended to supplant or limit the description of the claimed subject matter as provided in the claims as recited in Appendix A, as understood in light of the entire specification.

Appellants' invention is directed to a system and method for businesses to prepare mail pieces for direct mailings in which the format and design of the mail pieces are centrally controlled and preparation of the mail pieces is both economical and efficient. Independent claim 1 is directed to a method for generating a mailing that comprises "storing at a data center a design for each of a plurality of mail pieces, each of said designs being in a format viewable from a remote computer via a network;" (see Fig. 3, items 60 and 65 and corresponding description on page 6, lines 6-16 of the Specification), "receiving, at said data center, an order for a plurality of pieces of a first mail piece design from said remote computer via said network;" (see Fig. 5, item 150 and corresponding description on page 8, lines 30-32 of the Specification), "combining, using a processor at said data center, said order for said plurality of pieces of said first mail piece design with at least one other order for a plurality of pieces of a second mail piece design to produce a single print run;" (see Fig. 5, item 160 and corresponding description on page 9, lines 5-8 of the Specification), "arranging, using said processor, said single print run in a presort sequence based on recipient addressing information for said plurality of pieces of said first and second mail piece design;" (see Fig. 5, item 165 and corresponding description on page 9, lines 8-15 of the Specification), "printing each of said plurality of pieces of said first mail piece design and said plurality of pieces of said second mail piece design of said single print run in said arranged presort sequence on a corresponding print medium to produce a plurality of finished mail pieces in said presort sequence;" (see Fig. 5, item 170 and corresponding description on page 9, lines 16-32 of the Specification), and "mailing said plurality of finished mail pieces" (see Fig. 5, item 180 and corresponding description on page 10, lines 3-6 of the Specification).

Independent claim 18 is directed to a system for producing a mailing including a plurality of mail pieces that comprises "a remote computer coupled to a network;" (see Fig. 1, item 16 and corresponding description on page 4, lines 6-17 of the Specification), "a data base for storing

a design for each of a plurality of mail pieces;" (see Fig. 1, items 30a, 30b, 30n and corresponding description on page 4, lines 20-24 of the Specification), "a processor coupled to said data base, said processor being communicatively coupled to said network, said remote computer communicating with said processor via said network to provide an order for a plurality of mail pieces having a first design, said processor combining said order for said plurality of mail pieces having said first design with at least one other order for a plurality of pieces of a second design to produce a single print run and arranging said single print run in a presort sequence based on recipient addressing information for said plurality of pieces of said first and second mail piece design;" (see Fig. 2, item 34 and corresponding description on page 4, lines 19-20, of the Specification), and "a printer coupled to said processor to print each of said plurality of pieces of said first design and said plurality of pieces of said second design of said single print run in said arranged presort sequence on a corresponding print medium to produce a plurality of finished mail pieces" (see Fig. 2, item 36, and corresponding description on page 5, lines 5-9).

Additional features of the invention are discussed below in the Argument section of this Brief.

#### VI. Grounds of Rejection to be Reviewed on Appeal

A. Whether the subject matter defined in claims 1, 2, 5, 9, 18 and 19 is unpatentable over Mori et al. (US 5,982,994) and whether the subject matter of claims 3, 4, 6 and 7 is unpatentable over Mori et al. in view of Fabel (US 6,209,779).

#### VII. Argument

As Appellants discuss in detail below, the final rejection of claims 1-7, 9, 18 and 19 is devoid of any factual or legal premise that supports the position of unpatentability. It is respectfully submitted that the rejection does not even meet the threshold burden of presenting a

prima facie case of unpatentability. For this reason alone, Appellants are entitled to grant of a patent. In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

A. The subject matter defined by claims 1, 2, 5, 9, 18 and 19 is not obvious over Mori et al. (US 5,982,994).

Claim 1 is directed to a method for generating a mailing that comprises “storing at a data center a design for each of a plurality of mail pieces, each of said designs being in a format viewable from a remote computer via a network; receiving, at said data center, an order for a plurality of pieces of a first mail piece design from said remote computer via said network; combining, using a processor at said data center, said order for said plurality of pieces of said first mail piece design with at least one other order for a plurality of pieces of a second mail piece design to produce a single print run; arranging, using said processor, said single print run in a presort sequence based on recipient addressing information for said plurality of pieces of said first and second mail piece design; printing each of said plurality of pieces of said first mail piece design and said plurality of pieces of said second mail piece design of said single print run in said arranged presort sequence on a corresponding print medium to produce a plurality of finished mail pieces in said presort sequence; and mailing said plurality of finished mail pieces.”

Mori et al., in contrast, is directed to a high-speed network printer apparatus that can be used in common by LAN terminals (clients) having different communication protocols. As shown in Fig. 1 of Mori et al., reproduced below, the network printer apparatus 20 includes a printing mechanism 23 composed of a recording system and paper feeding system, a mailbox 51 provided with bins for accommodating printed paper so as to store printed paper in a designated bin, a client 52 and a communication path 53. The printing information is supplied from the client 52 through a connector 26 and received by a LAN interface driver 21b, which identifies the communication protocol. The communication protocol controller 21-3, 21-4, 21-5 or 21-6 corresponding to the identified communication protocol controls communication in accordance with the predetermined protocol and receives printing data. The spooling controller 21-8 stores the printing information in the hard disk 24 and creates a queue for printing jobs. The printer controller 22 reads out of the hard disk 24 the printing information corresponding to the printing job of the highest priority which the printing mechanism 23 prints the image on paper. If the

mailbox 51 is provided, the mailbox controller 20a obtains the number of the bin which is to store the printed paper directly or indirectly from the printing information and stores the printed paper in the bin. (Col. 6, line 30 to Col. 7, line 4).

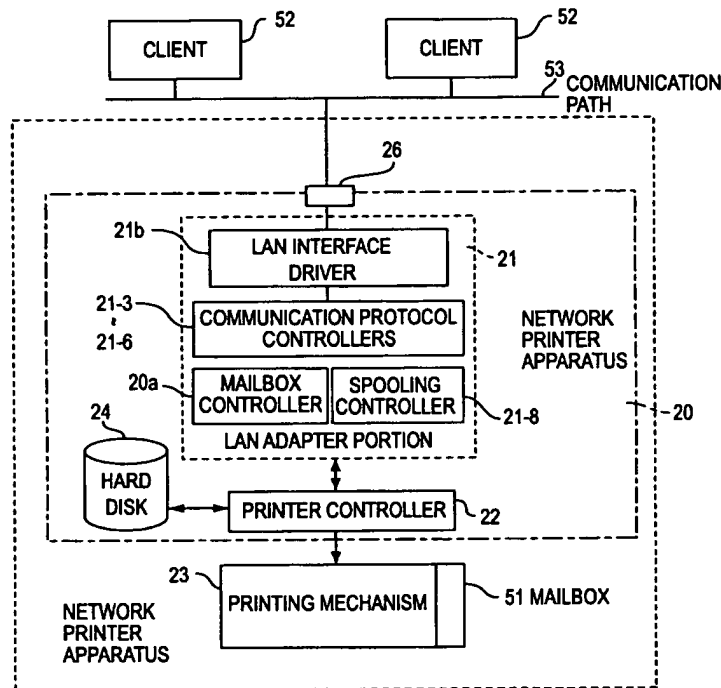


FIG. 1

There is no disclosure, teaching or suggestion in Mori et al. of combining an order for a plurality of pieces of a first mail piece design with at least one other order for a plurality of pieces of a second mail piece design to produce a single print run as is recited in claim 1. In Mori et al., each print job from a separate client is handled separately based on a priority designated by the queue. The Office Action contends that Col. 18, lines 54-55, which refers to the ability of the user to select single-side or both side printing for a print job, discloses this feature. Appellants respectfully disagree. The selection made by the user to print on only one side of a paper or both sides of a paper for the user's print job in Mori et al. is in no way related to combining the user's print job with another print job from a different user. There is no disclosure, teaching or suggestion in Mori et al. of combining said order for said plurality of

pieces of said first mail piece design with at least one other order for a plurality of pieces of a second mail piece design to produce a single print run as is recited in claim 1.

There is also no disclosure, teaching or suggestion in Mori et al. of arranging the single print run in a presort sequence based on recipient addressing information as is recited in claim 1. The Office Action contends that “Mori et al. obviously suggest about arranging a single print run in a presort sequence - Mori et al. teach in the abstract that printing jobs can be sorted out into the order of clients.” The Office Action appears to be equating the mailbox 51 of Mori et al. with arranging the print run in a presort sequence of the present invention. This is simply not correct. In Mori et al. a mailbox 51 is provided with a plurality of bins for accommodating discharged paper as a post-processing mechanism of the network printer apparatus. When a user requests a print job, the user can designate the number of the bin in the mailbox in which the printed paper will be stored for later retrieval by the user. Alternatively, there is a correspondence between a user name or a group name and a bin registered in the mailbox information management information in advance, so that designation of the bin in the mailbox for storing paper is not necessary at the time of requesting printing. (See Cols. 32-33). Thus, in Mori et al., each print job from a different user is kept separate from other user’s print jobs by placing each different print job into a different bin. There is no combining of print jobs, nor is there any arranging of combined print jobs into a presort order based on recipient addressing information in Mori et al. This is in direct contrast with the present invention in which orders for a first and second mail piece design are combined into a single print run, arranged in a presort sequence based on addressing information for the mail pieces, and printed in the arranged presort sequence. There is simply no disclosure, teaching or suggestion of any of these features in Mori et al.

There is also no disclosure, teaching or suggestion in Mori et al. of storing at a data center a design for each of a plurality of mail pieces as is recited in claim 1. In Mori et al., all of the printing information is supplied from the client, i.e., the workstation that generated the documents to be printed. There is, therefore, no storage of any types of designs for mail pieces in Mori et al. The Office Action contends that the hard disk 24 of Mori et al. can do the above claimed function. Claim 1 recites “storing at a data center a design for each of a plurality of mail pieces, each of said designs being in a format viewable from a remote computer via a network.”

The hard disk 24 in Mori et al. is located in a network printer apparatus 20 for storing printing information corresponding to print jobs that are subsequently read out and printed. A network printer apparatus, i.e., a printer, is not the same as a data center. Furthermore, storing printing information about print jobs sent to the printer is not the same as storing a design for each of a plurality of mail pieces, each of said designs being in a format viewable from a remote computer via a network as is recited in claim 1.

In the Advisory Action mailed on Nov. 23, 2005, it is stated that the “Cited prior art inherently suggest steps of combine different printings/(orders), arranging/command to print in an order (based on address/amount/name/receiving order . . .).” Appellants respectfully disagree. “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990 (emphasis in original).

As noted above, there is no disclosure, teaching or suggestion in Mori et al. of combining an order for a plurality of pieces of a first mail piece design with at least one other order for a plurality of pieces of a second mail piece design to produce a single print run, or arranging the single print run in a presort sequence based on recipient addressing information as is recited in claim 1. Nor are such limitations inherent in Mori et al. In Mori et al., each print job from a separate client is handled separately based on a priority designated by the queue. The selection made by the user to print on only one side of a paper or both sides of a paper for the user’s print job is in no way related to combining the user’s print job with another print job from a different user. Furthermore, in Mori et al., each print job from a different user is kept separate from other user’s print jobs by placing each different print job into a different bin. There is no combining of print jobs, nor is there any arranging of combined print jobs into a presort order based on recipient addressing information in Mori et al. The Advisory Action has not provided



any basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of Mori et al.

For at least the above reasons, Appellants respectfully submit that the final rejection as to claim 1 is in error and should be reversed. Claims 2, 5 and 9 are dependent upon claim 1, and therefore include all of the limitations of claim 1. For the same reasons the final rejection as to claim 1 is in error, Appellants respectfully submit that the rejection of claims 2, 5 and 9 is similarly in error and should be reversed.

Claim 18 includes limitations substantially similar to those of claim 1. For the same reasons given above with respect to claim 1, Appellants respectfully submit that the rejection of claim 18 is similarly in error and should be reversed. Claim 19 is dependent upon claim 18, and therefore includes all of the limitations of claim 18. For the same reasons the final rejection as to claim 18 is in error, Appellants respectfully submit that the rejection of claim 19 is similarly in error and should be reversed.

C. The subject matter defined by claims 3, 4, 6 and 7 would not have been obvious over Mori et al. in view of Fabel.

Claims 3, 4 and 6 are dependent upon claim 1, and claim 7 is dependent upon claim 6. Therefore, each of claims 3, 4, 6 and 7 includes all of the limitations of claim 1. As noted above with respect to claim 1, Mori et al. does not disclose, teach or suggest storing at a data center a design for each of a plurality of mail pieces, combining an order for a plurality of pieces of a first mail piece design with at least one other order for a plurality of pieces of a second mail piece design to produce a single print run, or arranging the single print run in a presort sequence based on recipient addressing information. The reference to Fabel does not cure any of the above deficiencies, as it was relied upon for other features. Specifically, Fable is directed to a mailer blank having an aperture to form a window allowing printed information to be viewed or read through this formed window. The formed window can have a transparent layer of material covering the aperture. (Col. 3, lines 45-50). The mailer blank can have a return receipt postcard which can be printed on both faces thereof by a single pass through a non-impact, simplex printer. The post card is provided with fold lines such that a unique folding pattern results in formation of a post card of standard size and uniform thickness, and having the variable printed

information ultimately positioned at desired location on both sides of the post card. (Col. 4, lines 9-20). There is no disclosure, teaching or suggestion in Mori et al. or Fable, either alone or in combination, of storing at a data center a design for each of a plurality of mail pieces, combining an order for a plurality of pieces of a first mail piece design with at least one other order for a plurality of pieces of a second mail piece design to produce a single print run, or arranging the single print run in a presort sequence based on recipient addressing information. For the same reasons the final rejection as to claim 1 is in error, Appellants respectfully submit that the rejection of claims 3, 4, 6 and 7 is similarly in error and should be reversed.

### VIII. Conclusion

In Conclusion, Appellants respectfully submit that the final rejection of claims 1-7, 9, 18 and 19 is in error for at least the reasons given above and should, therefore, be reversed.

Respectfully submitted,



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Attachments - Appendix A – Claims Appendix (3 pages)  
Appendix B – Evidence Appendix (1 page)  
Appendix C – Related Proceedings Appendix (1 page)

**APPENDIX A – Claims Appendix**

1. A method for generating a mailing comprising the steps of:

storing at a data center a design for each of a plurality of mail pieces, each of said designs being in a format viewable from a remote computer via a network;

receiving, at said data center, an order for a plurality of pieces of a first mail piece design from said remote computer via said network;

combining, using a processor at said data center, said order for said plurality of pieces of said first mail piece design with at least one other order for a plurality of pieces of a second mail piece design to produce a single print run;

arranging, using said processor, said single print run in a presort sequence based on recipient addressing information for said plurality of pieces of said first and second mail piece design;

printing each of said plurality of pieces of said first mail piece design and said plurality of pieces of said second mail piece design of said single print run in said arranged presort sequence on a corresponding print medium to produce a plurality of finished mail pieces in said presort sequence; and

mailing said plurality of finished mail pieces.

2. The method according to claim 1, wherein said network is the Internet.

3. The method according to claim 1, wherein said step of receiving an order further comprises:

receiving contact information for said plurality of pieces of said first mail piece design,

wherein said contact information is printed on each of said plurality of pieces of said first mail piece design .

4. The method according to claim 1, wherein said step of receiving an order further comprises:

receiving a recipient mailing list including a plurality of names,

wherein a respective one of said plurality of names is printed on a corresponding one of said plurality of pieces of said first mail piece design.

5. The method according to claim 1, wherein said step of receiving an order further comprises:

receiving customized information to be printed on said plurality of pieces of said first mail piece design.

6. The method according to claim 1, wherein said print medium is a post card having a first and second side.

7. The method according to claim 6, wherein said step of printing further comprises:

printing on said first and second side of said postcard.

8. Cancelled

9. The method according to claim 1, wherein said first mail piece design is for a first business, and said second mail piece design is for a second business.

10-17. Cancelled.

18. A system for producing a mailing including a plurality of mail pieces, said system comprising:

a remote computer coupled to a network;

a data base for storing a design for each of a plurality of mail pieces;

a processor coupled to said data base, said processor being communicatively coupled to said network, said remote computer communicating with said processor via

said network to provide an order for a plurality of mail pieces having a first design, said processor combining said order for said plurality of mail pieces having said first design with at least one other order for a plurality of pieces of a second design to produce a single print run and arranging said single print run in a presort sequence based on recipient addressing information for said plurality of pieces of said first and second mail piece design; and

a printer coupled to said processor to print each of said plurality of pieces of said first design and said plurality of pieces of said second design of said single print run in said arranged presort sequence on a corresponding print medium to produce a plurality of finished mail pieces.

19. The system according to claim 18, wherein said network is the Internet.

**APPENDIX B – EVIDENCE APPENDIX**

There is no evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 or any other evidence entered by the examiner and relied upon by Appellant in the appeal.

**APPENDIX C – RELATED PROCEEDINGS APPENDIX**

There are no appeals or interferences known to Appellants, their legal representative, or the assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.